



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/761,098	01/21/2004	Yukio Yamaguchi	60188-747	2437

20277 7590 04/15/2010
MCDERMOTT WILL & EMERY LLP
600 13TH STREET, N.W.
WASHINGTON, DC 20005-3096

EXAMINER

CHANG, LEONARD

ART UNIT	PAPER NUMBER
----------	--------------

2812

MAIL DATE	DELIVERY MODE
-----------	---------------

04/15/2010

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/761,098	Applicant(s) YAMAGUCHI, YUKIO	
	Examiner LEONARD CHANG	Art Unit 2812	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 November 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-8 and 16-25 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-8 and 16-25 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 21 January 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☒ Certified copies of the priority documents have been received in Application No. 09/244,074.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>20091124</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Information Disclosure Statement

1. The information disclosure statement (IDS) submitted on 11/24/2009 is in compliance with the provisions of 37 CFR 1.97. Accordingly, the information disclosure statement is being considered by the examiner.

Oath/Declaration

2. The reissue oath/declaration filed with this application is defective because it fails to identify at least one error which is relied upon to support the reissue application. See 37 CFR 1.175(a)(1) and MPEP § 1414.

The reissue declaration filed on 11/30/2009, does not *specifically identify the error* in the original patent.

The error statement stated “the original claims of U.S. PATENT No. 6,455,348 were only directed to a method ... and therefore did not recite a resin-molded semiconductor device having inner leads each including a groove” Is not considered a sufficient “error” statement since it does not *specifically identify* what was the error in the original patent since the device patent was granted to U.S. PATENT No. 6,081,029.

3. This application is objected to under 37 CFR 1.172(a) as lacking the written consent of all assignees owning an undivided interest in the patent. The consent of the assignee must be in compliance with 37 CFR 1.172. See MPEP § 1410.01.

A proper assent of the assignee in compliance with 37 CFR 1.172 and 3.73 is required in reply to this Office action.

The Consent of Assignee filed on 11/30/2009 indicated that Panasonic Corporation as the assignee (formerly Matsushita Electric Industrial, Co., Ltd). However, no official record has been provided that Panasonic Corporation is now the assignee of U.S. PATENT No. 6,455,348. The assignment is assigned to Matsushita Electronics Corporation.

4. The reissue oath/declaration filed with this application is defective because the error which is relied upon to support the reissue application is not an error upon which a reissue can be based. See 37 CFR 1.175(a)(1) and MPEP § 1414.

The newly added claims 16-25 are directed to a semiconductor device and based on the original claims are too narrow ("claiming less than I had right to claim"). However, the reissue application was filed *after* two-year limitation (i.e. after 6/27/2002) of the device patent U.S. PATENT No. 6,081,029. Thus, such error does not meet the "error" requirement under 35 USC 251 since the broaden claims were filed after two-year statutory limitation.

Specification

5. The amendment to the Specification filed on 1/21/2009 is improper. The deleted matter in a reissue application should be enclosed in a single bracket (i.e., "[[This]]" should be corrected to "[This]").

Art Unit: 2812

6. The status of 12/179,884 is unclear. It appears that 12/179,884 is a continuation reissue application of 10/761,098 rather than a divisional reissue application as the applicant stated.

Claim Rejections

7. **Claims 1-8 and 16-25** are rejected as being based upon a defective reissue declaration under 35 U.S.C. 251 as set forth above. See 37 CFR 1.175.

The nature of the defect(s) in the declaration is set forth in the discussion above in this Office action.

Note: This rejection based on a defective declaration was in the previous Office Actions of record. However, the Declaration was not corrected in response to the rejection(s).

8. **Claims 16-25** are rejected under 35 U.S.C. 251 as being broadened in a reissue application filed outside the two year statutory period.

The instant reissue application was filed based on the U.S. Patent 6,455,348 (issued on 9/24/2002) by adding device claims 9-15 (now claims 16-25). However, U.S. Patent 6,455,348 claims are solely directed to methods of making a semiconductor device. U.S. Patent 6,455,348 was granted based on the application 09/521,670 which is a divisional application of 09/244,074. 09/244,074 matured into U.S. Patent 6,081,029 (issued 6/27/2000) which the claims are solely directed to a semiconductor device.

Therefore, the added claims 9-15 (or claims 16-25) in the instant reissue application should have been filed under the device patent U.S. Patent 6,081,029.

Art Unit: 2812

Moreover, the added claim 16 is broader than the patent claims 4 or 6 in U.S. Patent 6,081,029 by deleting “support lead is partially bent to function as a spring”. Thus, even if the reissue application was filed within two-years of U.S. Patent 6,455,348, the applicant may not present device claims that broaden the scope of the device patent U.S. Patent 6,081,029 after 6/27/2002 (two year date).

Thus, it appears that filing the instant reissue application based on the method patent U.S. Patent 6,455,348 instead of the device patent U.S. Patent 6,081,029, the applicant is circumventing two year statutory limitation for broadening claims of the original patent.

A claim is broader in scope than the original claims if it contains within its scope any conceivable product or process which would not have infringed the original patent. A claim is broadened if it is broader in any one respect even though it may be narrower in other respects.

9. **Claims 16-25** are rejected under 35 U.S.C. 251 as being an improper recapture of broadened claimed subject matter surrendered in the application for the patent upon which the present reissue is based. See *Pannu v. Storz Instruments Inc.*, 258 F.3d 1366, 59 USPQ2d 1597 (Fed. Cir. 2001); *Hester Industries, Inc. v. Stein, Inc.*, 142 F.3d 1472, 46 USPQ2d 1641 (Fed. Cir. 1998); *In re Clement*, 131 F.3d 1464, 45 USPQ2d 1161 (Fed. Cir. 1997); *Ball Corp. v. United States*, 729 F.2d 1429, 1436, 221 USPQ 289, 295 (Fed. Cir. 1984). A broadening aspect is present in the reissue which was not present in the application for patent. The record of the application for the patent shows that the broadening aspect (in the reissue) relates to claim subject matter that applicant

Art Unit: 2812

previously surrendered during the prosecution of the application. Accordingly, the narrow scope of the claims in the patent was not an error within the meaning of 35 U.S.C. 251, and the broader scope of claim subject matter surrendered in the application for the patent cannot be recaptured by the filing of the present reissue application.

Each independent claims 1, 2, 4, and 6 in U.S. Patent 6,081,029 recites "support lead is partially bent to function as a spring" which from the prosecution history appears to be the reasons for allowance. Thus, the deletion of limitation "support lead is partially bent to function as a spring" in the pending claim 16 is subject matter surrendered in the original prosecution, and deleting such limitation is considered impermissible recapture.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 U.S. PATENT Q2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 U.S. PATENT Q2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 U.S. PATENT Q 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 U.S. PATENT Q 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 U.S. PATENT Q 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 U.S. PATENT Q 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Art Unit: 2812

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

10. **Claims 16-25** are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 2, 3, 6, 7, and 8 of U.S. Patent No. 6,081,029. Although the conflicting claims are not identical, they are not patentably distinct from each other because the terminology "inner leads" is substantially the same as "signal-connecting leads" and "resin" normally is an "encapsulant".

11. **Claims 16 and 17** are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 26 and 27 of copending Application No. 12/179884. Although the conflicting claims are not identical, they are not patentably distinct from each other because the terminology of "**recess**" is substantially the same as "**grooves**".

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

If the same or similar claims are presented in more than one of the multiple reissue applications, the possibility of statutory double patenting (35 U.S.C. 101) or non-statutory (judicially created doctrine) double patenting should be considered by the examiner during examination, and the appropriate rejections made. A terminal disclaimer may be filed to overcome an obviousness type double patenting rejection. The terminal disclaimer is necessary in order to ensure common ownership of the reissue patents throughout the remainder of the unexpired term of the original patent. MPEP § 1451.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to LEONARD CHANG whose telephone number is (571)270-3691. The examiner can normally be reached on Mon-Thurs 9:00 - 6:00 EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Charles Garber can be reached on (571) 272-2194. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.U.S. Patent to.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a U.S. PATENT TO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Leonard Chang/
Examiner, Art Unit 2812

Application/Control Number: 10/761,098

Page 9

Art Unit: 2812

/Alexander G. Ghyka/

Primary Examiner, Art Unit 2812